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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,995	02/09/2001	Ken Kutaragi	SCEI 18.302	5881

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/780,995

Applicant(s)

KUTARAGI ET AL.

Examiner

Raquel Alvarez

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to communication filed on 7/28/2006.
2. Claims 1-15 are presented for examination.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (5,835,087 hereinafter Herz).

With respect to claims 1, 4-6, 8, 11-18 Herz teaches an in contents-advertising method wherein advertisement information provided beforehand is included in digital contents activated by a user terminal (Summary). Activating in a user terminal in a program by a user the digital content and determining that the digital contents have been activated by the user (col. 55, lines 45-54); transferring an identifier of the digital contents and an identifier of the user to an advertising information server when the digital contents have been activated by the user (col. 55, lines 45 to col. 56, lines 1-14); selecting and retrieving advertising information by the advertising information server based on the digital contents identifier and the user identifier and transferring the retrieved advertising information to the user terminal (col. 60, lines 11-20); inserting the retrieved advertising information in the digital contents such that the advertising information is automatically selected and retrieved from the advertising server,

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transferred to the user terminal and inserted in the digital contents when the digital contents are activated in the user terminal by the user (col. 55, lines 45 to col. 56 lines 1-14; col. 60, lines 11-20 and col. 61, lines 4-26).

With respect to the digital contents being activated in a game program. Herz teaches the content is activated in a news service program. It would have been obvious to a person of ordinary skill in the art to have changed the news service program of Herz to a game program in order to attract fun, younger users to the system.

With respect to the newly added feature of based on information indicating that advertisements may be inserted, advertising information included in the digital content is updated with the retrieved advertising information. In Herz, the lists of advertisements are pre-selected based on the target profile of the article (col. 55, lines 50-62) and the amount that advertisers are willing to pay (col. 40, lines 8-28).

With respect to claims 2-3, Herz further teaches providing the advertising information by the advertising server to the contents provider for insertion in the digital contents (Figure 1).

Claims 7 and 9, further recite advertising fees based on said recording results. Official notice is taken that it is old and well known to charge based on recording/product quality. For example, a low/inferior quality recording or product gets a lower fee than a high quality product or recording in order to compensate for good

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performance. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertising fees based on said recording results in order to obtain the above mentioned advantages.

Claim 10 further recites the advertisers providing the times of the advertisement insertion and providing said ads based on said advertisements information specified from said advertiser. Official notice is taken that is old and well known for advertisers to select the times slots and structure in which they want the advertisements to be displayed to the customers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the advertisers providing the time of the advertisements insertion because such a modification would allow the advertisers to target the proper audience based on the time period selected.

#### **Response to Arguments**

4. Applicant requests that the finality of the rejection be withdrawn based on the incompleteness of the rejection with regard to claims 14-18. The Examiner wants to point out that claims 14-18 are mainly claiming known characteristics of a game/movie program and therefore the Examiner has taken official notice of changing the Herz news program to a game/movie program. Having a game/movie program will also include a header with at least a company name and a title and the remaining characteristics of components of claims 14-18, so therefore the Examiner didn't see the need to reject

these claims separately since a game/movie program has the known characteristics claimed in claims 14-18.

5. Applicant argues that there's a fundamental difference between the news clipping program and the game program recited. The Examiner is keeping her position that the steps being claimed would have been performed the same regardless if they were implemented in a news program or a game program and therefore is an obvious variation.

6. With respect to the newly added feature of based on information indicating that advertisements may be inserted, advertising information included in the digital content is updated with the retrieved advertising information. In Herz, the lists of advertisements are pre-selected based on the target profile of the article (col. 55, lines 50-62) and the amount that advertisers are willing to pay (col. 40, lines 8-28). Therefore, Herz teaches selecting and making a determination indicating that advertisements will be inserted into the content before the content is presented to the user.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a person of ordinary skill in the art is presumed to have some knowledge in the art. In this case

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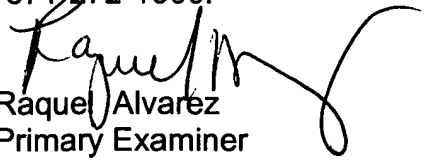
given the fact that Herz teaches news programs which have a general adult audience, one of ordinary skill in the art would have thought of attracting a more younger audience by implementing the steps of Herz in a video/movie program.

**Point of contact**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Raquel Alvarez  
Primary Examiner  
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R.A.

10/3/2006